

**REMARKS**

The Examiner has indicated that claims 36 and 50 are not rejected and are free of the art of record.

As requested by the Examiner, the Brief Description of Figures 1A-1B and Figure 2 have been amended to include sequence identifiers. In addition, Applicants submit herewith a CDR and paper copy of the sequence listing which includes the sequences identified in Figures 1 and 2. The specification has been amended to include deposit dates and complete name and address of depository.

Claims 29, 32, 34-54, and 57-60 were pending in the application. Claims 34 and 36 have been canceled. Claims 29, 32, 37, and 57 have been amended to more particularly point out and distinctly claim the subject matter Applicants regard as the invention. Accordingly, upon entry of the present amendment, claims 29, 32, 33, 35, 37-54, and 57-60 will be pending in the instant application.

Support for the amendments to the claims may be found throughout the specification and claims, as originally filed. Specifically, support for the amendments to claims 29, 32, and 57 to recite that the indicator composition comprises ***a recombinant expression vector encoding a human c-Maf protein*** of SEQ ID NO.:2, ***wherein the human c-Maf-coding sequences are operatively linked to regulatory sequences that allow for constitutive expression of human c-Maf in the indicator cell*** (claims 29 and 32) or a human c-Maf protein comprising the NheI/XbaI fragment of pHu-c-Maf (ATCC Accession No. 98671) ***wherein the human c-Maf-coding sequences are operatively linked to regulatory sequences that allow for constitutive expression of human c-Maf in the indicator cell*** (claim 57) can be found in previously examined claim 36. *No new matter has been added by way of these amendments.*

No additional search is required and no new issues have been raised by the amendments made herein; support for the amendments made can be found in the claims as previously pending as outlined above. It is believed that the amendments made herein have obviated the rejection of claims 37 and 57 under 35 U.S.C. §112, Second Paragraph, and claims 29, 32, 34-35, 37-49, 51-54, and 57-60 under 35 U.S.C. §102(b). Furthermore, in view of the amendments and arguments set forth herein, the number of issues for appeal has been reduced. Therefore, the claim amendments made herein are permissible under 37 C.F.R. §1.116 as reducing the number of issues for appeal, and Applicants respectfully request that the present Amendment be entered.

Any amendments to and/or cancellation of the claims are not to be construed as an acquiescence to any of the rejections set forth in the instant Office Action, and were done solely to expedite prosecution of the application. Applicants hereby reserve the right to pursue the subject matter of the claims as originally filed in this or a separate application(s).

#### ***Withdrawal of Rejection of Certain Claims***

Applicants acknowledge the withdrawal of the rejection of claims 29, 31, 32, 34-54, and 57-60 under 35 U.S.C. §112, second paragraph. Applicants also acknowledge the withdrawal of the rejection of claims 29, 31, 34, 37, 40, 42, 43, 48 and 50 under 35 U.S.C. §102(a), as being anticipated by Hedge, *et al.* (*Mol Cell Biol*, 1995).

#### ***Rejection of Claims 37 and 57 Under 35 U.S.C. §112, Second Paragraph***

The Examiner has rejected claims 37 and 57 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner states that “[c]laims 37 and 57 have been amended to recite and to encompass an invention that consists of specific constructs that have been deposited in ATCC. Since the constructs are essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise readily available to the public.”

In response, the specification has been amended and a copy of the deposit information for the *Eschericia coli* strain containing the plasmid, pHu-c-Maf, (ATCC Accession No. 98671), is submitted herewith. In addition, a declaration regarding the deposit is submitted herewith. Accordingly, Applicants respectfully request that the rejection of claims 37 and 57 Under 35 U.S.C. 112, first paragraph be reconsidered and withdrawn.

***Rejection of Claims 29, 32, 34-35, 37-49, 51-54, and 57-60 Under 35 U.S.C. §102***

The Examiner has rejected claims 29, 31, 32, 34-35, 37-49, 51-54, and 57-60 under 35 U.S.C. §102(b), as being anticipated by Hodge, *et al.* (*Mol Cell Biol*, 1995). Applicants assume the Examiner meant Hodge, *et al.* (1996) *Science* 274:1903-1905 and request clarification if this is not the case. The Examiner has also rejected claims 29, 31, 34, 40, and 42 under 35 U.S.C. §102(b), as being anticipated by Kataoka, *et al.* (*Mol Cell Biol*, 1995). The Examiner states that

Hodge, *et al.* teaches the assay methodology and use of human cells. The present disclosure teaches that SEQ ID NO:2 and the fragment cloned and deposited as pHu-c-Maf are human sequences. Since Hodge, *et al.* teaches the use of human cells, and that these cells have genes that are responsive to c-Maf, these cells must contain the sequence disclosed as SEQ ID NO:2 or that contained in the deposited pHu-c-Maf clone. Similarly, Kataoka, *et al.* use human cells in the assay methods taught.

Applicants respectfully traverse these rejections and submit that this rejection does not pertain to these claims as currently amended.

For a prior art reference to anticipate a claimed invention, the prior art must teach *each and every element* of the claimed invention. *Lewmar Marine v. Barient*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). Claims 29, 32, and 57, as currently pending, and thus claims dependent therefrom, have been amended to recite the limitations of claim 36 which the Examiner has indicated is not rejected and free of the art. Specifically the claims have been amended to recite that the indicator composition comprises *a recombinant expression vector encoding a human c-Maf protein* of SEQ ID NO.:2, *wherein the human c-Maf-coding sequences are operatively linked to regulatory sequences that allow for constitutive expression of human c-Maf in the indicator cell* (claims 29 and 32) or a human c-Maf protein comprising the NheI/XbaI fragment of pHu-c-Maf (ATCC Accession No. 98671) *wherein the human c-Maf-coding sequences are operatively linked to regulatory sequences that allow for constitutive expression of human c-Maf in the indicator cell* (claim 57). Hodge, *et al.* and Kataoka *et al.*, either alone or in combination, do not teach or suggest each and every limitation of the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of the foregoing rejections.

**CONCLUSION**

Reconsideration and allowance of all the pending claims is respectfully requested. If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the examiner is urged to call the undersigned at (617) 227-7400.

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Respectfully submitted,

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Attachments